RECORD AND BRIEFS

SUPREME COURT, U.S.
AUG 25 2017

No. 16-712

IN THE

Supreme Court of the United States

OIL STATES SERVICES, LLC,
Petitioner,

v.

GREENE'S ENERGY GROUP, LLC, ET AL.,
Respondents.

ON WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF OF AMICI CURIAE ALLIACENSE LIMITED LLC IN SUPPORT OF PETITIONER

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INTEREST OF AMICUS

Alliacense Limited LLC is in the business of managing intellectual property assets of its clients including providing licensing and patent prosecution. Alliacense provided counsel to MCM Portfolio LLC in the IPR, the Federal Circuit appeal, and the ultimate petition to the Supreme Court in *MCM Portfolio LLC v. Hewlett-Packard*, No. 15-1330, *cert. denied*, October 11, 2016. Alliacense has continued interest in the issues presented by the present case.[1]

SUMMARY OF ARGUMENT

Congress has no power to authorize the Patent Trial and Appeal Board ("PTAB") to revoke patents for invalidity without trial by jury because prior to 1791, the year the Seventh Amendment[2] was ratified, inventors had a right to a trial by jury in an English court of law before their patents could be revoked for invalidity thereby giving such revocation actions a Seventh Amendment right to trial by jury. The common law remedy was known as a *scire facias*; the action was commenced either on the common-law side of Chancery or at King's Bench, and was exclusively tried at King's Bench and to a jury. The BIO and even this court in the past have assumed that because a *scire facias* normally was

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[1] All parties have consented to the filing of this brief. No counsel for any party authored this brief in whole or in part, and no entity, other than amici, or their counsel, made a monetary contribution to the preparation or submission of this brief.

[2] "In Suits at common law, ... the right of trial by jury shall be preserved...." Const. amend. VII (hereinafter "Seventh Amendment").

returned in Chancery, that it was an equitable proceeding and that even if jury trials were conducted, they were only advisory, not binding. But is not true that the writ *scire facias* was a bill in equity. A *scire facias,* a common law writ that can be identified as such from its use of Latin, was instead returned on the law-side of Chancery; and the Chancellor at all times was acting with his ordinary, common law powers, not his extraordinary, equitable powers. We attach a copy in the appendix of pages 79 and 80 of Cokes 4th Institute (1644) for the court to easily verify the truth of the matter.

Inter partes review (IPR)[3] provides the same remedy, *revocation,*[4] and the same grounds, *invalidity* as do scire facias, albeit, limited only to the claims challenged.[5] Both are contested proceedings. Both begin with a petition by an interested party to the government. The common law proceeding was pursued in the name of the King, but the real party in interest was the petitioner who had to post a very large bond to pay the attorney's fees of the patent owner.

Because IPR does not provide a jury trial, the statute authorizing IPR is unconstitutional.

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[3] 35 U.S.C. §§ 311-319.

[4] 35 U.S.C. § 318(b) (Claims determined unpatentable cancelled by certificate). *Cf.*, 35 U.S.C. § 288 (Action may proceed on valid claims even if patent contains an invalid claim.) A modern patent varies from those at the time of the founding because they have multiple claims varying from one another in scope that narrower claims may be valid even though broader claims read on the prior art. By statute, an action may proceed even if a patent claims an invalid claim.

[5] Under *Tull v. United States,* 481 U.S. 412 (1987) the remedy (here, revocation) is the most important factor.

The unconstitutionality of IPR is not negated by any legitimate public rights analysis. Actions to determine "statutory" legal rights of the type determined prior to 1791 in England, and this includes *scire facias* actions to revoke patents for invalidity, are categorically excluded from a public rights analysis because they have a Seventh Amendment right.

This amicus describes the English court system, the procedures for revoking patents, and the relevant English history from 1624 to 1791. By 1791, the Privy Council had stopped revoking invention patents leaving only the legal remedy of *scire facias*. Parliament first attempted to limit the jurisdiction of the Privy Council in the 1624 Statute of Monopolies. But, in 1626, the first year of Charles I, the Privy Council stayed common law revocation proceedings. Only in 1753, did the Privy Council stop revoking invention patents, apparently at the behest of William Murray, later Lord Mansfield, who then was Solicitor General. *Rex v. Arkwright*, 1 Carp. P.C. 53, 1 WPC 64 (K.B. 1785), was one of the first patent revocation actions tried after 1753. We attach a copy of the case to demonstrate that the issues tried were validity based on prior art, prior invention and an inadequate specification, issues common to today. The case was tried at King's Bench and to a jury. The patent was ordered revoked by Lord Mansfield after a petition for retrial was denied.

Scire facias actions were normally commenced on the law side of Chancery, but tried in King's Bench. Because they were filed in Chancery, the government has argued that the actions were equitable (apparently not even knowing that Chancery had a law side) thereby providing no basis

for a Seventh Amendment right. They may further argue that the jury trials that did take place were only advisory as if the Chancellor was acting with his extraordinary (equitable-side) powers, as opposed to his ordinary (law-side) powers. However, we demonstrate that *scire facias* to revoke patents for invalidity were legal from filing to judgment. We further demonstrate that equity could not and did not revoke patents for invalidity since an adequate remedy at law was available.

ARGUMENT

1. **Actions to revoke patents for invalidity have a Seventh Amendment right because such actions were tried exclusively in the common law courts of England prior to ratification of the Seventh Amendment in 1791.**

    a. **The Seventh Amendment extends to patent revocation actions.**

This court first interpreted the *Seventh Amendment* in *Parsons v. Bedford*, 28 U.S. (3. Pet.) 433 (1830) "By common law, [the framers] meant what the constitution denominated in the third article "law;" not merely suits, which the common law recognized among its old and settled proceedings, but suits in which legal rights were to be ascertained and determined...." *Id.* at 446-447. The "thrust of the [Seventh] Amendment was to preserve the right to jury trial as it existed" in England "in 1791," *Curtis v. Loether*, 415 U.S. 189, 193 (1974), "the date of the Amendment's ratification by the original states," *Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654 (1935). Under this formulation, *scire facias* actions, the exclusive remedy employed to revoke invention patents from

1780, fall squarely within the *Parsons/Curtis* analysis because such actions were filed at law, tried at law, determined the validity of a patent, and revoked patents that were invalid. Moreover, it is the remedy of revocation of the patent that is the most important feature of *scire facias* actions for Seventh Amendment purposes. *Tull v. United States*, 481 U.S. 412, 421 (1987).

b. A proper public rights analysis for statutory rights must compare the statutory action to similar common law actions.

The Federal Circuit in *MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284, 1290-1293 (Fed. Cir. 2015) and the government BIO both insert a public right's analysis before determining whether there is a violation of the Seventh Amendment. This form of argument never considers whether IPRs are truly comparable to common law *scire facias* actions, but rather assumes they are not comparable, even though IPR and *scire facias* provide the same remedy for the same legal grounds as *scire facias*. This faulty argument resulted, in *MCM Portfolio,* in a determination that it was constitutionally permissible to assign the trial of patent revocation to the USPTO where a jury trial is not available; thus effectively sweeping away the Seventh Amendment rights of patent owners. Any analysis that permits this is seriously flawed.

This court's public rights analysis has heretofore categorically excluded state common law claims as public rights. *See, e.g., Stern v. Marshall*, 564 U.S. 462, 131 S. Ct. 2594, 2609, 2611 (2011). A first reason such actions are excluded is that they were litigated in the courts of England prior to 1789. *Id.*

at 2611 citing *Murray's Lessee v. Hoboken Land & Improvement Co.*, 59 U.S. 272 (18 How.) 272 (1856). A second reason they are excluded is that, to the extent legal, they have a Seventh Amendment right. *Cf.*, *Granfinanciera, SA v. Nordberg*, 492 U.S. 33, 51-52 (1989).

c. Only novel types of statutory actions may be assigned to administrative tribunals; but IPR are identical to *scire facias* actions in both grounds and remedy.

But when the right is created by federal statute and not by state common law, the public rights analysis requires that the statutory action involving that right be "novel" -- a type not known to common law. *Ibid.* When, as here, the grounds, patent validity, and the remedy, patent revocation, provided by IPR are the same as *scire facias* actions at common law, the public rights analysis must stop. The action must be tried in an Article III court and to a jury. *Ibid.*

2. English history of patent revocation actions: 1624-1791.

a. The 1624 Statute of Monopolies required monopoly patent revocation actions be tried exclusively in the common law courts.

Section I of the Statute of Monopolies, 21 Jac.1, c. 3 (1624), declared all prior "monopoly" patents void, listing exceptions in sections VI-IX. Section VI permitted patents for "new manufactures" to "the true and first inventor" that others at the time of the patent grant shall not use." Section II declared that

only the common law courts could void patents.[6] (The *Case of Monopolies*,[7] had previously established authority of the common law courts to "declare void" monopoly patents.) As put by Webster,

> [A]ll monopolies, &c., to be void by the common law, has provided by this that they shall be examined, heard, tried, and determined, in the courts of common law, according to the common law, and not at the council table, star chamber, chancery exchequer chamber, or any other court of like nature, but only according to the common laws of the realm, and not otherwise.

Edward Coke, *The Third Part of the Institutes* 182-183 (1644); Webster, Thomas. *Reports and Notes of Cases on Letters Patent for Inventions.* Vol. 1. T. Blenkarn, 1841 at 30.

b. In 1626, Charles I stayed common law patent revocations and resumed exclusive Privy Council jurisdiction.

Prior to the 1624 statute, only the crown or its Privy Council had voided patents. Their authority to do so was based on a revocation clause included in every monopoly patent from the time of Elizabeth.[8]

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[6] "[A]ll monopolies, and all ... patents ... shall be "examined, heard, tried and determined, by and according to the common laws of this realm, and not otherwise."

[7] *Darcy v. Allen*, 11 Co. Rep. 84b. 77, 77 Eng. Rep. 1260, 1 WPC 1 (K. B. 1602). (*Darcy v. Allen* was an infringement suit. The plaintiff was denied a remedy because in the opinion of the court the patent was void.)

[8] Davies, D. Seaborne. "The early history of the patent specification." *LQ Rev.* 50 (1934): 86, 260 (pts.1-2) at 102-103. The clause read in part,

The 1624 statute specified that only the common law courts could void patents – and that seemed to exclude the Privy Council (and the crown) from its traditional role.

In 1626, a glassmaker openly began to infringe a glassmaking patent held by Mansell, and indicated his intention to bring a *scire facias* to revoke it.[9] The Mansell patent had been excepted in Section VIII of the 1624 statute from general repeal of all prior patents because of its strategic importance.[10] Edward Coke had earlier reported that Mansell, a vice Admiral of England, was not the inventor of glassmaking, but of only the furnace that used sea coal. Lord Coke recommended that the patent be limited to the production of glass using sea coal.[11] 1

> [I]if on examination of the patent before the Privy Council, or a specified number of its members, before whom the patentee had been called, the grant was certified to be inconvenient or prejudicial to the realm, then on the signification of the pleasure of the Crown in that respect ... or upon a certificate to that effect made by the Privy Council ... the patent immediately, or at the end of a specified period of notice, was to be void and frustrate.

Ibid. Arkwright's patent, discussed below, included a revocation clause that also included prior use and prior invention as grounds for revocation.

[9] Walterscheid, Edward C. "The early Evolution of the United States patent law: antecedents (part 3)." J. Pat. & Trademark Off. Soc'y 77 (1995): 771 at 774.

[10] *See*, 1 WPC 32 (noting the exception, but commenting that Mansell was not the inventor).

[11] Coke's report on the Mansell patent indicates that monopoly patents for invention were investigated and were limited to the scope of the invention on pain of revocation. During the late 1700s, the English developed a caveat system

WPC 27. The patent, No. 22, was renewed in 1624 and limited to the use of sea or pit coal to make glass. 1 WPC 17-26. The patent also prohibited others from using timber to make glass. The crown was trying to reduce the use of timber, a strategic resource for building ships. *Id.* at 17.

After initially giving its approval for the *scire facias*, the Privy Council soon reconsidered: "They think it of dangerous consequences and far trenching upon the prerogative that patents granted on just grounds and of long continuance should be referred to the strict trial of common law, wherefore they order that all proceedings *at* law be stayed."[12] Unstated, the revocation would have undermined England's national security.

The Privy Council thereafter continued its prior practice of revoking patents on petition. English scholar Hulme, in his review of Privy Council records, reported dozens of such Privy Council proceedings in the late 1600s through 1753, most involving allegations of prior use or prior invention. Hulme, E. Wyndham, *Privy Council Law and Practice of Letters Patent for Invention from the Restoration to 1794,* 33 L.Q.R 63, 180 (1917) (2 Pts.).

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that was effectively an opposition system. Issue concerning novelty and invention were tried to a jury. Sean Bottomley, *The British Patent System During the Industrial Revolution 1700–1852*, at 35–39, 53–55 (2014).

[12] Walterscheid "The early Evolution of the United States patent law: antecedents (part 3)", *supra*, at 774, quoting State Papers, Domestic, December 6, 1626. Charles I, an absolutist Monarch like his father, James VI and I, also began issuing monopoly patents that were in clear disregard of the limitations of the Statute. Fox, Harold George. *Monopolies and patents: a study of the History and future of the patent monopoly.* University of Toronto Press, 1947 at 127-145.

c. **In 1753, the Privy Council was presented with a constitutional problem when the common law courts challenged the ruling of the Privy Council in the matter of the James patent.**

Hulme identifies the 1752 proceedings involving the James patent, No. 626, as a turning point between the old and new systems of patent law. One Baker had petitioned the Council to revoke the James patent on grounds that a Baron Schwanberg was the inventor of the claimed fever powder. Dr. James responded with an affidavit saying that the invention was for a pill and a powder of multiple compounds, making it immaterial if one of them was invented by the Baron. The matter was dismissed. Baker then brought an indictment for perjury against Dr. James and requested that the Privy Council order its clerk to produce the original affidavit of Dr. James. The Privy Council referred the matter to its Attorney General. *Id.* at 189-191. The advice was that the petitioner did not have a legal right to have the affidavit produced and the Baker petition was dismissed. *Ibid.* William Murry, later Lord Mansfield and a strong champion of the courts, was then Solicitor General. Hulme argued that the Council acted to settle a quarrel with Lord Mansfield regarding the constitutional authority of the Privy Council to try disputes regarding validity. Hulme, "*Privy Council Law and Practice of Letters Patent for Invention from the Restoration to 1794*," *supra*, at 184.

d. After the events of 1753, and at least from 1780, only the common law courts of England revoked patents for invalidity.

Thereafter, and even considering that patents still contained boilerplate revocation clauses allowing the Privy Council to revoke patents for prior use or prior invention, every petition to the Council requesting revocation of an invention patent was dismissed, apparently with a "recommendation" that the patent owner bring an action at law that the validity of the patent might be tried.[13] The last Privy Council revocation occurred in 1779. The case involved a cannon making patent. The revocation occurred after a four-year delay that was intended to allow the patent owner to bring an action at law to try validity. He refused to bring the action, despite having already obtained an injunction. The revocation was based on national security, not validity. The council considered further delay to be prejudicial to the ability to conduct the war in the American colonies.[14]

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[13] E.g., the petition of 35 opticians for vacating Dollond's patent, No. 721. *Id.* at 191. It is interesting to note that now the revocation clause inserted into patents included additional language not included in the revocation clause at the time of Elizabeth. The revocation clause in Arkwright's patent, for example, allowed the Privy Council to revoke patents because "the said invention is not a new invention as to the public use and exercise thereof...; Or not invented and found out by the said [name of the inventor]." Compare, English patent boilerplate at the time of George III, at 31, with the grounds for the *scire facias* in *Rex v. Arkwright,* at 61, of Davies, John. *A Collection of the most important cases respecting Patents of Invention and the Rights of Patentees.* Reed, 1816.

[14] National security is well within the public rights exception to the right of trial in an Article III court. *See, Murray's Lessee v. Hoboken Land & Improvement Co.*, 59 U.S.

The government shifted to the use of *scire facias* actions where trial would be to a jury. One of the first *scire facias* actions was *Rex v. Arkwright*, 1 Carp. P.C. 53, 1 WPC 64 (K.B. 1785).[15] The action was brought only after Arkwright had first sued nine competitors for infringement and lost because the court held his specification to be insufficient.[16] Several years elapsed. Arkwright then sued again and this time won.[17] That second judgment issued in February of 1785. But, while that second action was under way, the King, on petition to the Attorney

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(18 How.) 272, 285 (1856); citing *Luther v. Borden*, 48 U.S. (7 How.) 1 (1849); *Doe v. Braden*, 7 U.S. (16 How.) 635 (1854).

[15] Other cases prior to 1791 include *Rex v. Jacob*, 496 nb 169 (Middlesex, 6 Dec. 1782), MMSS I: 767; *Rex v. Else*, (1785) 1 CPC 104; 1 WPC 76 (K.B.); *Rex v. Eley*, (1790) Times (Lon.), Dec. 9, 1790, at 3.

[16] *Arkwright v. Mordaunt*, 1 WPC 56 (C.P. 1781).

[17] *Arkwright v. Nightingale*, 1 WPC 60 (C.P. 1785). Regarding the prior verdict adverse to Arkwright, the court said,

> It has been said, that many persons have acted upon an idea that Mr. Arkwright had no right, he having failed to establish it when this cause underwent an examination in another place, in which the event was unfavourable to him. If the question at present were what damages Mr. Arkwright should have received for the invading that right, I would have allowed the parties to have gone into evidence to show to what extent persons have acted upon the faith of the former verdict; but the question now is upon the mere right, and if the result of this cause is in favour of the plaintiff, the verdict will be with one shilling damages. A future invasion of this right would entitle Mr. Arkwright to an action for damages, but in the present case they are not asked.

Id. at 61.

General, brought a *scire facias* in Chancery. Trial was at King's Bench and the verdict of invalidity was for the crown.[18] Lord Mansfield, on denying retrial, ordered the patent repealed.[19]

e. *Rex v. Arkwright*, a *scire facias* to revoke a patent for invalidity, was commenced on the law side of Chancery, tried at King's Bench and resulted in judgment by Chief Justice Mansfield of King's Bench ordering the patent cancelled.

To preempt any potential argument that English patents and patent litigation of the late 1700s were unlike those of today, we discuss in some detail in *Rex v. Arkwright*, 1 Carp. P.C. 53, 1 WPC 64 (K.B. 1785).[20] (The appendix attaches Webster's report of the case. A-4.)

Per Thomas Webster, patents issuing from the end of Anne's reign included a proviso requiring the grantee to file a specification "particularly to describe and ascertain the nature of his invention,

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[18] *Rex v. Arkwright*, *supra*, 1 WPC at 64.

[19] Webster's report of the case is set forth in the appendix at A-4. To prevail, Arkwright had to prevail on all points, the Crown, any. *See*, *Rex v. Arkwright*, *supra*, 1 WPC at 73. At that time, if any of the claimed inventions was not novel, the entire patent was found invalid and voided. Arkwright claimed 10 different components to his machine, many of which were proven to be not his.

[20] For a discussion of the history surrounding the case, *see*, Hewish, J. "Rex vs Arkwright, 1785: A Judgment for Patents as Information," World Patent Information, Vol. 8, No. 1, 1986, pp. 33-37, where, it appears, a large group of rival cotton manufacturers banded together to petition for a writ to put an end to Arkwright's continued effort to enforce his patent despite his initial adverse ruling on validity.

and in what manner the same is to be performed." 1 WPC at vi and 8. *See also*, Bottomley, Sean. *The British Patent System during the Industrial Revolution 1700–1852: From Privilege to Property.* Vol. 28. Cambridge University Press, 2014: 46-50 (describing a gradual adoption of the requirement dating from 1711). Thereafter, patents could be revoked for providing an insufficient specification. One of those so revoked was owned by Richard Arkwright.

The major problem with the Arkwright patent (on a cotton carding machine) was an insufficient specification. It described several components, but not a word as to how they cooperated. Evidence produced proved that some of the components that went into making the carding machine were in public use or the invention of others. The jury verdict was for the crown.

That the summary of law and facts and the court's jury instructions show that the English had developed the fundamentals of modern patent law prior to 1791. The most important development thereafter is the statutory mandate for patent specifications to claim the invention and that a patent office examine "claims" before grant. (Patent) Act of 1836, Ch. 357, 5 Statutes at Large 117, § 7. While this development has led to a host of issues, such as claim construction, and other validity issues, courts today still decide the validity of a patent claim based on whether the invention claimed by a claim is new, whether the specification describes the claimed invention and whether it enables one of ordinary skill to make and use it.

3. **English Procedure for revoking patents at law.**

   a. **The Court of Common Pleas, the Court of Exchequer and the King's Bench were the law courts of England.**

Lord Coke in Coke, Edward. *The Fourth Part of the Institutes of the Laws of England: Concerning the Jurisdiction of Courts* (1644), published at W. Clarke and Sons, 1817 (*4th Inst.*), describes the jurisdiction of the sundry courts in England, Scotland, Ireland and Wales. The table of contents lists well over 100 courts, but among these, only three were common law courts: The Court of Common Pleas, the Court of Exchequer and the Court of King's Bench – the latter having a division located in Chancery. The Court of Common Pleas tried cases between parties other than the King. *4th Inst., supra*, at 99. Exchequer was concerned with the King's revenue. *4th Inst., supra*, at 112. King's Bench tried cases where the King was a party. *4th Inst., supra*, at 71.

   b. ***Scire facias* actions were filed on the law side of Chancery and tried at King's Bench.**

The index of the *4th Inst.* States that "A *scire facias* to repeal a patent may be brought in either King's Bench or in the Chancery." Pages 72 (King's Bench), 79 and 88 (Chancery) are referenced. "A *scire fac.* repeal a patent of the King may be brought in this court." *4th Inst.*, at 72. The *scire facias*, if filed in Chancery, was filed on its law side and not on its equitable side. *4th Inst.*, at 79. The Chancellor, the sole judge of Chancery, considered the writ with his ordinary (law) powers as opposed to his extraordinary (equitable) powers. *4th Inst.*, at 88.

Coke states that the grounds for *scire facias* are double patenting, false suggestion, and contrary to law. *Ibid.* In the case of double patenting, the first patentee may bring a suit against the second. In the latter two cases, the king is the party. *4th Inst.*, at 88.[21] An aggrieved subject petitioned the King to repeal the patent. "Where a patent is granted to the prejudice of a subject, the king of right is to permit him upon his petition to use his name for the repeal of it." 1 WPC 41, quoting from *Sir Oliver Butler's Case*, H. 31 & 32 Car. 2, 2 Vent. 344., 2 Ventr. 344; *4th Inst., supra,* at n. 3.[22]

The procedures described by Lord Coke are also described in *Rex v. Arkwright*, 1 WPC 64 at 64-65. Webster's note states that proceedings of this type

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[21] Coke writes,

> This writ scire facias to repeal letters patents doth lye in this ordinary court of justice and three cases. The first, when the king by his letters patents doth grant by several letters patents one and the same thing to several people, the former patentee shall have a scire facias to repeal the second patent. Secondly, when the king granteth any thing that is grantable upon false suggestion, the king by his prerogative *jure regio* may have a scire facias to repeal his own grant. Thirdly, when the king doth grant any thing, which by law he cannot grant, he *jure regis* (for advancement of justice and right) may have a scire facias to repeal his own letters patents.

4th Inst., Cap. 8 at 88.

[22] This court similarly held that only the government might bring an action for the repeal of a patent. *Mowry v. Whitney*, 81 U.S. (14 Wall.) 434, 439 (1871) ("[W]e are of opinion that no one but the government, either in its own name or the name of its appropriate officer ... can institute judicial proceedings for the purpose of vacating or rescinding the patent which the government has issued to an individual.").

originated in the Petty Bag Office. (The Petty Bag Office was where the records of patents issued by the crown were kept. *U.S. v. American Bell Tel. Co.*, 128 U.S. 315, 360 (1888).) A draft writ is "taken to the Atty. Gen., who thereupon may grant his fiat, upon the prosecutor and to sureties entering to a bond of a £1000, conditioned to pay the defendant his costs, taxed as between attorney and client." *Rex v. Arkwright*, 1 WPC at 64.

As mentioned, *a scire facias* normally commenced on the common-law side of Chancery. That side was a separate court, a division of King's Bench. It was entitled *coram domino rege in cancelleria, et additio probat minoritatem*, translated: King's Bench division in Chancery. *4th Inst.* at 79. Because Chancery had no facilities to conduct jury trials, the Chancellor transferred the record to King's Bench in Westminster Hall. As Coke notes at pages 79-80 of the *4th Inst.*, this court and the court of King's Bench were considered a single court for the purposes of trying cases. Appendix A-1 is a copy of pages 79-80 from an 1817 version of the *4th Inst.*[23] As showed by the Arkwright case, the proceedings terminated with King's Bench ordering the patent repealed.

4. Because there was an adequate remedy at law, the Chancellor had no jurisdiction to revoke a patent using his (extraordinary) equitable powers.

Even though *scire facias* actions to repeal patents for invalidity provided a complete and adequate remedy at law, the government briefs heretofore,

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[23] A judgment that the patent was void was returned to Chancery where the Chancellor would cancel it. *Rex v. Arkwright, supra*, 1 WPC at 65.

and some of this Court's opinions, have expressed the view that patent revocation actions may be determined by the Chancellor acting in his *equitable* capacity. *See e.g., U.S. v. Stone*, 69 U.S. (2 Wall.) 525, 535 (1864); *Mowry v. Whitney*, 81 U.S. (14 Wall.) 434, 440 (1871) (citing *Stone*), *U.S. v. American Bell Telephone*, 128 U.S. 315, 359-361, 364-365 (1888).[24] In England, this was "constitutionally" not possible. One of the compacts between the commons and the King limited equity to disputes where there was no adequate remedy at law:

> In the parliament holden 13 R. 2. the commons petitioned to the king, ... That no person should appear upon a writ *De quibusdam certis de causis*,[25] before the chancelor or any other of the councell, where recovery is therefore given by the common law: whereunto the King's answer is, The king willeth as his progenitors have done, saving his regalty.[26]

Coke, *4th Inst.*, Cap. 8 at 82. Parliament agreed to the same principle.

> 1. Rot. par. 2 R. 2. nu. 18. the high court of parliament relieveth but such as cannot have remedy but in parliament. The

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[24] This court said Chancellor was acting with his "ordinary" powers when using his equitable powers. This potentially causes confusion because Coke referred to the use of the Chancellor's *ordinary* powers as being those of a *common-law* judge, his *equitable* powers being *extraordinary*. *4th Inst.* at 79.

[25] Subpoena to testify.

[26] Spelling unchanged except for the substitution of "s" for "f" as appropriate.

parliament for matters determinable at the common law doth remit the parties.

...

3. Whereas matters of fact by the common law are triable by a jury of twelve men, this court should draw the matter *ad aliud examine*, that is, to judge upon deposition of witnesses, which should be but evidence to a jury in actions real, personal, or mixed.

This court of equity proceeding by English bill is no court of record, and therefore it can bind but the person only, and neither the state of the defendants lands, nor property of his goods or chattels.

Id. at 84. To the same effect is the Statute of Monopolies. As explained by Lord Coke, its limitation of revocation actions to the common law courts was intended, among other things, to limit the jurisdiction of Chancery from considering patent validity. Edward Coke, *The Third Part of the Institutes* 182-183 (1644).

This court has held that the Seventh Amendment imposes a no-adequate-remedy-at-law limitation on the scope of equity jurisdiction.

[W]henever, respecting any right violated, a court of law is competent to render a judgment affording a plain, adequate and complete remedy, the party aggrieved must seek his remedy in such court, [] because the defendant has a constitutional right to a trial by jury....

Scott v. Neely, 140 U.S. 106, 109-110 (1891); *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 510-511 (1959).

The English authority relied on by *Mowry*[27] and *American Bell*[28] to support their view that equity generally was a proper forum to revoke patents is *Atty. Gen. v. Vernon*, 1 Vern. 277, 23 Eng. Rep. 468 (1684) (*Vernon I*). This reliance is misplaced.

In *Vernon I*, the Attorney General brought a bill in equity to revoke a patent "under the Duchy's seal" granting the defendants land from the King's Duchy of Lancaster. The grounds were fraud. The allegation was that the value of money and lands exchanged for the grant was far less than the value of the property conveyed. There were no surveys done prior to the patent issuing. The value of the lands conveyed was not stated.

The defendants pled that the matter was properly decided in a court of law, and ought to be determined in the Duchy. The King objected that the Duchy court was a revenue court, not a court of law. Further, that *scire facias* was not an available remedy because the patent was not of record in Chancery and because *scire facias* relieved only deceits appearing in the body of the patent. The Lord Keeper overruled the plea, but reserved the question of jurisdiction of equity to the full hearing. *Id.* at 282.

At the full hearing, the Chancellor and the Lord Chief Justice and the Chief (of the Court of Common Pleas) decided that the legal remedy, *scire facias*, did not provide a remedy, let alone an adequate remedy:

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[27] 81 U.S. at 440.

[28] 128 U.S. 359-361, 364-365, 369.

Lord Chief Baron Mountague said, "... that no *scire fac.* would lie in this case, the deceit not appearing in the body of the grant...." He thought, "[H]is *Lordship* might justly decree a re-conveyance, and that the patent should be delivered up and cancelled: and he supposed care would be taken that the consideration should be restored."

Lord Chief Justice Jones said, "I take it, that a *scire fac.* will not lie in this case, or if it would, yet the deceit appears not in the body of the patent; and therefore a *scire fac.* will not reach it. The value is not mentioned in the patent, and shall there be no way then where the King is deceived for his Majesty to be relieved? That would be to put him in a worse condition than a subject."

Lord Chancellor, ... "The first question then is, whether this court upon an *English* bill may in any case decree letters patent to be delivered up and cancelled; and he was clear of opinion, that had the patent passed ever so regularly, that yet this court might have decreed it to be delivered up. Fraudulent contracts and bargains are properly relievable here; the precedents are common. ... (Emphasis in original.)

Atty. Gen. v. Vernon, 1 Vern. 370, 387-390, 23 Eng. Rep. 528, 535-536 (1685) (*Vernon II*). The patent was ordered delivered up and cancelled. Vernon in exchange received back his £7000, and separately £400 plus interest for the value of the lands Vernon had conveyed to the crown. Note that this sort of remedy -- the restoration of the status quo ante requiring that both parties re-convey to do justice --

would not be available by simply revoking the patent via the writ *scire facias*.

Vernon II stands for the proposition that a *scire facias* is not an adequate remedy to rescind a transaction for fraud where a patent is granted in an exchange for value and the fraud is in the exchange, and not in the patent. *Ibid.* *Vernon II* makes it abundantly clear that when a legal remedy is available, equity has no jurisdiction. Because *scire facias* actions provide a complete and adequate remedy at law for revoking a patent for invalidity, equity did not have jurisdiction to even try validity, let alone revoke a patent. Moreover, as noted above, the Chancellor's role in *scire facias* actions was that of a common law judge, not that of a judge in equity.

For the same reasons, equity today in the United States has no jurisdiction to try patent validity (without consent). *Scott v. Neely*, *supra*, at 109-110. To allow equity to try cases where there was an adequate remedy at law would be to violate the Seventh Amendment. *Ibid.* It is only a short leap to say that the same is true of Article II courts trying cases where there is an adequate remedy at law.

CONCLUSION

In conclusion, from 1780, *scire facias* for repeal of patents for invalidity were tried to a jury at King's Bench.[29] Patent owners have a Seventh Amendment right to a trial by jury before their patents might be revoked for invalidity. Since IPR revoke patents for invalidity without a jury trial, IPR are unconstitutional.

Respectfully submitted,

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[29] It is also worth of note that validity was uniformly tried to a jury whether the action was for infringement, an injunction or revocation. In *Bramah v. Hardcastle*, 1 Carp. 168 (1789), an infringement case, validity was tried to a jury. Similarly, in *Rex v. Arkwright*, 1 Carp. P.C. 53, 1 WPC 64 (1785) a *scire facias* to repeal a patent and *Boulton and Watt v. Bull*, 1 Carp. P.C. 155 (1796) that began bill in equity. ("The bill was filed for an injunction to restrain the defendant from infringing the patent, and an injunction was obtained, that the question as to the validity of the patent might be tried at law.") *Boulton and Watt* confirms that equity courts did not try patent validity, but instead referred trial to the common law courts where juries were available. A temporary injunction issued on the presumption that the patent was valid. *See*, note 19, *supra*. *See*, also, Jones, William John. "*An Introduction to Petty Bag Proceedings in the Reign of Elizabeth I.*" *California Law Review* (1963): 882-905, at 886-887 (legal disputes arising in equity were tried at King's Bench and to a jury).

APPENDIX

1. Edward Coke, the Fourth Part of the Institutes of the Laws

(of England concerning the Jurisdiction of the Courts, Clark & Sons, London (1817) (Notes omitted))

In the chancery are two courts, one ordinary, *coram domino rege in cancellaria*, [a] wherein the lord chancelour or lord keeper of the great ſeale proceeds according to the right line of the laws and ſtatutes of the realm, *ſecundum legem et conſuetudinem Angliæ*. [b] Another extraordinary according to the rule of equity, *ſecundem æquum et bonum*. And firſt of the former court.

[c] He hath power to hold plea of *ſcire fac'* for repeal of the kings letters patents, of petitions, *monſtrans de droits*, traverſes of offices, partitions in chancery, of *ſcire fac'* upon recogniſances in this court, writs of *audita querela* and *ſcire fac'* in the nature of an *audita querela* to avoid executions in this court; [d] dowments in chancery, the writ *de dote aſſignanda* upon offices found, execution upon the ſtatute ſtaple, or recogniſance in nature of a ſtatute ſtaple upon the act of 23 H. 8. but the execution upon a ſtatute merchant is retornable either into the kings bench, or into the common place, and all perſonall actions by or againſt any officer or miniſter of this court in reſpect of their ſervice or attendance there. [a] In theſe if the parties deſcend to iſſue, this court cannot try it by jury, but the lord chancelour or lord keeper delivereth the record by his proper hands into the kings bench to be tried there; becauſe for that purpoſe both courts are accounted [b] but one, and after triall had to be remanded into the chancery, and there judgement to be given. But if there be a demurrer in law, it ſhall be argued and adjudged in this court. Nota, the legall proceedings of this court be not inrolled in rolls, but remaine *in filaciis* being filed up in the office of the pety-bag. [c] Upon a judgement given in this court a writ of error doth lie retornable into the king's bench: [d] the ſtile of the court of the kings bench is *coram rege* (as hath been ſaid) and the ſtile of this court of chancery is *coram domino rege in cancellaria, et additio probat minoritatem*. And in this court the lord chancelour or the lord keeper is the ſole judge: and in the kings bench there are four judges at the leaſt.

1. Arkwright's Patent from Webster's Patent Cases at 56

ARKWRIGHT'S PATENT (*a*).

Title. Letters patent to Richard Arkwright, 16 December, A. D. 1775, "for certain machines for preparing silk, cotton, flax, and wool, for spinning."

Specification. I, the said Richard Arkwright, do hereby describe and ascertain the nature of my said invention, and declare that the plan thereof, drawn in the margin of these presents, is composed of the following particulars; that is to say:—

For bruising the flax to render the fibres susceptible of division. No. 1, a beater or breaker of seeds, husks, &c., and a finer of the flax, hemp, and other articles which are to be prepared for dressing, in which (a) is a wheel with teeth, which, by acting upon a lever, raises the hammer (c), the lever being moveable upon the centre (d).

For hackling the bruised hemp. No. 2, an iron frame with teeth at (a), working against a lower frame with like teeth at (b); this lower frame is firmly connected to a wooden frame by means of the screws (c, c); the upper teeth are made to act against the lower by means of the joints (d, d, d, d) (*b*).

The present feeding apparatus. No. 3 is a piece of cloth with wool, flax, hemp, or any other such materials spread thereon, as at (a).

The crank for stripping off the cotton in a slicer. No. 4 is a crank and a frame of iron with teeth at (a), being moveable at the joints (b, b, b, b,) by means of a crank, and by

a cord turning the pulley or wheel (c); this motion of the teeth (a) works them backwards and forwards upon the cylinder No. 5, and dischargeth the cotton, wool, &c., from it at (d).

The doffer cylinder.

No. 5 is the last-mentioned cylinder, which hath fillet cards: behind this cylinder, No. 3 delivers its contents upon another cylinder (e).

The rollers for drawing and roving.

No. 6 consists of rollers fixed to a wooden frame, the contents of No. 5 being brought to it at (a), and going through at (b), produceth it a proper size (f); (c, c) are brushes for cleaning the machine.

The revolving can machinery.

No. 7, a cylindrical box for twisting the contents of No. 6 at (b); (a, a) are two rollers, one moving the other, between which the contents of No. 6 passeth into the cylinder (b); (c) is a dead pulley fixed to the frame; (d) a cord which, passing from the pulley (c), moves the rollers (a, a); (F) a wheel, the movement of which is brought from (F *c*) No. 10, and is fixed to No. 6 (*d*).

The twisting machinery.

No. 8, a machine for twisting the contents of No. 6, in which (d, d) is a frame of iron; (b) a roller, on which a bobbin, (c) is fixed; this is turned the same as No. 7, that is, by a dead pulley, or wheel fixed to a wooden frame, at (g) (*e*).

The bobbins of the roving machines.

No. 9, a spindle and flyer, being fixed to No. 6, for twisting the contents from (b) in No. 6; (d) is a pulley under the bobbin, which hath a communication by a band to No. 10 at (d, d), it being a conical or regulating wheel, which moves the bobbin quicker or slower as required (*f*).

The pulley work of the roving machines.

No. 10, a spindle, which being fixed to No. 6 at (a) worketh No. 7, No. 8, or No. 9, at (F, F, F), by the pulley (F, c); (d), a regulator for No. 9; (b), a socket, having a bolt going through (d, d) and (F, c) to (G), stops or sets the whole going by means of a catch (a), for the pulley (G, G) being loose upon the spindle, (o) a lever, moveable about (k), raiseth or falleth the bolt (b) (*g*).

In witness, &c.

2. Rex v. Arkwright

From Webster's Patent Cases, London (1844), at 64.

The King v. ARKWRIGHT
Cor. Buller, C.J. 25 June, 1785

Buller, J.: Gentlemen of the jury, this is a *scire facias,* brought to repeal a patent granted to the defendant for the sole use of instruments or machines which he represented to his majesty that he had invented, and which would be of great utility to the public in preparing silk, cotton, flax and wool for spinning; and that these machines are constructed on easy and simple principles, very different from any that had yet ever been contrived: that he was the first and sole inventor thereof, and that the same had never been practised by any other person whatsoever. It was upon this representation made by the defendant, that he obtained a patent now in question. The questions for your decision are three: First, whether this invention is new? Secondly, if it is being new, whether it was invented by the defendant? And, thirdly, whether the invention is sufficiently described by the specification?

It seems to me that the last question is the question of greatest importance: because, if you should be of the opinion upon that question that the specification is not certain enough, it may have the effect of inducing people who apply for patents in the future times to be more explicit in the specifications, and, consequently, the public will derive a great benefit from it: and, therefore, I will say to you the evidence upon that point first, and will endeavour to state it separately from all the evidence which is applicable to the other points of the cause. Upon

this point it is clearly settled at law, that a man to entitle himself to the benefit of a patent for a monopoly, must disclose his secret and specify his invention in such a way that others might be taught by it to do the thing for which the patent is granted, for the end and meaning of the specification is, to teach the public, after the term for which the patent is granted, what the art is, and it must put the public in possession of the secret in as ample and beneficial a way as the patentee himself uses it. This I take to be clear law, as far as it respects the specification; for the patent is the reward, which, under the act of parliament, is held out for a discovery; and, therefore unless the discovery be true and fair, the patent is void. If the specification, in any part of it, be materially false all or defective, the patent is against the law against law, and cannot be supported.

It has been truly said by the counsel, that if the specification be such that the mechanical men of common understanding can comprehend it, to make the machine by it, it is sufficient; but then it must be such that the mechanics may be able to make the machine by following the directions of the specification, without any new inventions or additions of their own. The question is, whether, upon the evidence, the specification comes within that I have stated to you to be necessary by the law, in order to support it.

The prosecutors have attacked it in almost every part. First, the witnesses the witness say the feeder No. 3 cannot be made from the specification. Another says, rollers were made prior to 1767; in 1769 the they were the same as this, and those used by the defendant; the one was fluted, and the other covered with letter; first they were fluted wood upon

an iron axis; the other was the same, only covering with calves' leather; that he rigidly made them of a different proportion, and one to move faster than the other.

If there was any alteration the defendant made that was material, and ought to be stated, but in speaking of that article, the specification is perfectly silent as the material or the form which in which it should be made.

A witness, Kay, says, one roller turn faster than the other; and there it was a used in this, because it was to draw the cotton finer. In this also the specification is perfectly silent. In the plan one appears to be something smaller than the other, but how much, or what were to be the relative dimensions, or upon what scale they were to be made, the specification says nothing. Crofts, who was employed by the defendant to draw up the specification, told the defendant it was imperfectly done, and would not answer the purpose; defendant said he meant it should operate as a specification, but to be as obscure as the nature of the case would admit.

I began with this evidence, because it is very material to be considered whether the specification, in any part of it, bears a doubt; because the obscurity of it was pointed out to the defendant before he made it, and he then professed to make it as obscure as he could; his object was to get the benefit from the patent so far as putting money in his own pocket, but as to the benefit the public were to receive, it was to be kept back as far as it could. Immison says, that from the specification he should have a parallel cylinder, and not a spiral one, but this is the one used by the defendant. As to the rollers, it does not

appear from the specification some were to go faster than others; from the specification, without other sources, it is impossible to say how they should be made, as there is no scale or plan to work by. A roller is necessary to the feeder to give regular interaction to the work; it will not answer without it. From the knowledge, he has now, he should add a roller if he was directed to make the machine. But that does not prove the specification to be sufficient, because if a man from the knowledge he has got from three trials, and seeing people immediately employed about it, can make use of it, it is his ideas improve the plan, and not the merit of the specification; if he makes it complete, it is his in ingenuity, and not the specification of the inventor. He says as to an No. 5, will not work five minutes together before it will be entirely full of cotton; he is asked, supposing cotton was to be spread upon the feeder only the breath of the fillers, would it have any effect? He says it would not do even then.

(The learned judge commented on the evidence of several other witnesses to the imperfection of the specification.)

Mr. Pilkington says, that Mr. Arkwright gave him some cases which he was to present to the House of Commons, and desired the witness would read them, and promised to send him more by his servant, which he did. Those who were delivered by the defendant seem to me to be material, because they show what the defendant sense of this business was immediately after the first trial. It has appeared from what has been said upon both sides, and it was so stated in this case, that he was beat upon the first trial upon the subject I am now stating to you, that is, the specification. He admits that he has not properly specified how the machine was

made, and he says that he purposely (in prevention of an evil, that foreigners may not get them) omitted to give so full a description of his inventions in the specification attending to the last patent as he otherwise would have done. This he admits, and he goes on and states a trial in Westminster Hall in July last, at a large expense, when solely by not describing so fully and accurately the nature of his last complexed machines, as was strictly required by law, a verdict was found against him: he bows with the greatest submission to the court and the verdict against him, and he deprecates the favour of parliament.

Now in a case where intervention is lucrative to so enormous a degree as you have heard, and where the verdict was given against him upon a particular point, had he not been most thoroughly convinced that the verdict was right, or if he should by any explanation have supported his specification, it is to be conceived for three years and a half he would lie by and totally lose the benefit of his patent? But accepting this application to parliament, which does not go upon the grounds of his patent being good, but abandoning it on account of his own fault, and desiring favour and bounty there, he relinquishes the patent for three years and a half.

This is the evidence upon the part of the prosecutor against the specification, and it is material to see a little how the defendant's counsel endeavours to support it. Here is the specification and states ten different instruments; it is a minute by them that as to No. 8, it is of no use, and never was made use of by the defendant in his machine. It is also admitted, No. 9 stands exactly in the same situation, as these could not be put into the machine. This is a little extraordinary, for if he meant to make

a fair discovery, why load it thus with things that they make no use of, and which are totally unnecessary? That could answer no purpose but to perplex. But, say the counsel, we will show you that there were two machines, and that they were two distinct things, for, say they, No 3, 4, and 5, are the material parts of one machine, and those alone afford all the information necessary. Then, besides that, there is the roving machine, which consists of No. 6, 7 and 10, joined together. If that be the truth of the case, and there are two distinct machines to be made up by the parts only of the instrument specified in this plan, let us see whether it is said so in the specification; – there is not a word of it. It begins with the first, or No. 1, which is a breaker or beater of seeds and husks, and a finer of the flax, hemp, and other articles which are to be prepared for dressing. Then, says the counsel, there was a difference as of those things, because the hammer was proper for the hemp, and not proper for wool; if there was to be that difference, it was necessary for the defendant to stated it in the specification; but he has made no distinction; his left to those who are to learn his art and secret the use the same machine for every part of it. He does not distinguish between the cotton and the flax; specification states that is proper for everything. Is it so? It is admitted it is not. Is there any thing which states that these parts are for two machines, and how they are composed? That the specification is totally silent about. What is there in the specification that can lead you to say that you must make use of three things for one of the machines and three for the other, in which three for one or the other? And even if it were so, what is to become of the other four? If those are of no use but to the to be thrown in merely to puzzle, I have no difficulty to say upon that ground alone the patent is

void, for it is it is not that fair, full, true discovery which the public have a right to demand from an individual who, who, under the sanction of parliament, gets so great a reward as monopoly for fourteen years together.

However, upon the part of the defendant, they have called several witnesses to show you it is perfectly intelligible, and that they can make the machines from the specification. Wilkinson took his information, or a great deal of it, from the defendant himself, and supposing it true that he or any other person instructed by the defendant, and having seen what he does, can make a machine from the specification, yet that will never support it, unless other people from the specification itself, who have any knowledge in the business, can also do it. That is not the case with this man; but the last thing he says is also material thing against the patent, for he says, for different purposes different proportions of the rollers are necessary. How is any man to find that out? It is not said in specification it must be different in one case from the other, and that you are to be have different roles for hemp or for cotton. All this remains to be the subject of a future discovery. Moore says, with due attention to the old machine, and an accurate attention to the specification, I could direct a skillful artificer to make the machine. That is all that a very ingenious sensible man can say of the specification. He has examined the instruments and the machine, and seen a great deal of it between the trials, and at last he believes, with all the extreme caution that I have mentioned to you, that he could direct a skillful artificer to make the machine. He says, that as to No. 3, a piece of cloth with cotton or any other material that was to be carded, rolled up in it, were surely move much

better and more steadily with a roller within side, but it would not to do without it. If wanted, he thinks it would be easily occur to a mechanic to put it in, that is, that a sensible man would have understanding enough to supply any defect in the specification; but in this it proves the specification is insufficient. It will not do of itself, but wants something to be added, it is deficient, and there is nothing in the specification that imports that there should be roller in it.

Now it is submitted by the former witnesses, if there are sections of rollers, there ought to be a scale, and there is no scale, there is nothing in the plan to show the different comparative velocities of the rollers, but there will be a difference, because the one is larger than the other in diameter.

You see how that applies to this part of the evidence. There is nothing, he says he, that shows what the difference of velocity should be, that remains for the experiment hereafter. Is that the case with the defendant? No, he knew to a certainty what it was. The man that comes to give an account of the invention, says, I had calculated it, and the difference of the velocities was to be as five to one; that this is the way I made my rollers; now the defendant has not said a word of that in the specification. In that he has kept back the knowledge he had as to the size of the rollers, and velocity, and is left to people to find it out as chance may direct.

Wood put No. 4, 5, 6, and 7, together and that machine he has worked ever since; he did not recollect that the defendant used anything else. If that be true, it will blowup the patent at once; he says he believes nobody that ever practised would

find anything necessary upon this paper but the No. 4, 5, 6, and 7; he should look after no others. Now if four things only when necessary instead of 10, the specification does not contain any good account of the invention. As to the can, he may use of it without rollers at the mouth; he thinks it answers just the same without it.

This is the evidence that relates the specification upon the one side and the other. You see upon the part of the prosecution they have called you to very ingenious man, that seem to be much beyond what they are called, mechanics in life; they have all told you it was impossible for them to make the machine according to the specification.

Upon the other hand, several respectable people are called upon the part of the defendant, who say they could do it, but that there is a difference in the description; most, if not every one of them, have looked at and seeing how the machines were worked by the defendant, and have got their knowledge by other means, and not from the specification and plan alone; besides, they admit the manner the defendant works is not consistent with the plan laid down, particularly as to the cylinder, a particular part of the business, for Moore says, this upon the face of it must be taken to be a parallel, whereas that which plainly appears to be used is a spiral; besides, after all this, they have spoken most of them in a very doubtful way, particularly Mr. Moore, who qualified his expression in the way which I have stated to you, and the others qualifying their expressions, saying they think upon the whole they could do it. Suppose it perfectly clear they could with the subsequent knowledge they had acquired, yet if it be true that sensible men that know something of this particular business, mechanics in general, cannot do it, it is not

so described as is sufficient to support this patent. It will be for you to say upon this part of the case whether you are satisfied the specification is such, as, with the plan, it may be made from it or not, taking the old machine into its assistance, which by the by the specification has not taken the notice of as known. If you think it is not sufficiently described, that alone puts a complete end to this cause, and then it would be unnecessary to trouble you with any other.

As to the other points, there are two; first, whether it is a new invention; and, in that next place, whether it was an invention made by the defendant. Now if, in your opinions, it is material to go into these points, I think the law in general is very different on them from what I have stated in the specification, because in the case of an invention many parts of the machine may have been known before, yet if there be any thing material and new which is an improvement of the trade, that will be sufficient to support a patent; but whether it must be for the new addition only, or for the whole machine, that would be another question. It seems to me not to be necessary now the state precisely how that would be, because his patent is attacked upon every ground that there is nothing new; therefore I will go over the articles one by one, and see what is stated upon the different articles which are here mentioned.

No. 1 it is said is not stated by the specification to be joined to anything else, and therefore it must be taken to be a distinct thing. It is admitted that it is not a new discovery, for Emerson's book was produced, which was printed a third time in the year 1773, and that is precisely the same as this. Lees says he is the inventor of the old feeder; that he

made it in 1772, and in August, 1772, he worked with it; and that it is now commonly used in this country. He has never seen the defendants used, but the description of the defendants is the same as his.

This also shows, first of all that it is no new invention; secondly, it is not invented by defendant, for this invention is spoken of as used before the time of the patent; and in the next place, it is prove to you not to be the invention of the defendant, by the person who actually invented it. It is proved that the crank (No. 4) was invented between 13 and 14 years ago by Hardgreave, and use publicly in two factories where men came to work. If so, that will put an end to this article of the crank. Some of the witnesses have proved them made in great numbers, and using different factories publicly, and have proved it by persons who made them. Upon the part of the defendant, the witnesses never had having heard of it may be perfectly true, and yet no contradiction to the evidence for the prosecution. As to No. 5, the fillet cylinder, Wood proves it is used long before the defendant's patent; he confirms what was said by the other witnesses; and what the other witnesses have said against it is nothing at all to this article; for here it is proved to be used in both ways, in the manner the defendant has used it now, and likewise being carded quite through.

Now if it was in use both ways, that alone is an answer to it; if not, there is another question, whether the stripe in it makes a material alteration? for if it appears, as some of the witnesses say, to do as well without the stripes and to answer the same purpose, if you suppose the stripes never to have been used before, that is not such an invention as will support the patent; upon that ground it is fully answered.

As to No. 6, there is no contradiction to the evidence of Hayes and Kay, that the rollers were made before, and used in the different ways I have stated to you, and that the defendant got the secret from them. Then the 7th article is what they call the can. Holt says, the only difference between the two, the spinning machine and the present roving machine, is that the latter has a can – and indeed that at one time was admitted by the counsel for the defendant.

If it be so, it brings the case to a short point indeed, for if nothing else is new, the question is, whether it is material or useful? The witnesses upon the part of the prosecution say it is of no use at all. In the first place, they had that before which answered the same purpose, though not made exactly the same form; was open at the top, it twisted around and laid the thread precisely in the same form, and had the same effect this has. So if it was new it is of no use, but if they say it is not new, for it was not precisely the same shape, in substance it is it was the same thing; that is not contradicted. That part also stands without any contradiction upon the part of the defendant, for the defendant's witnesses satisfy themselves with telling you they think it intelligible, and it might do without the roller, though it might not be so effectual as with the roller. It is admitted by several it could do without, that appeared from this experiment made; they showed you by one of the engines, how it did with the roller and how without; and that it was done without just the same as with it. As to 8 and 9, it is admitted those are entirely out of the cause, and may be used, says the counsel for the defendant instead of No. 7.

But it is a question whether this is the fair construction of the specification. Suppose it was so, it is perfectly clear defendant has never used either of them, and some of the witnesses tell you they cannot use them at all. One tells you they cannot be used, and, therefore, is a little unfortunate they got into the specification, if nothing more was meant than the make a fair discovery of what is useful; but in this manner the defendant description is given. As to No. 10, nothing is said about it for the defendant. First, Mr. Moore said it was not difficult to the conceive it; but there is no witness that says at all what the use of it is: so this seems to stand without any evidence at all.

Gentlemen, thus the case stands as to the several component parts of this machine; and if upon them you are satisfied none of them were inventions unknown at the time this patent was granted, or, that they were not invented by the defendant; upon either of these points the prosecutor is entitled to your verdict.

If upon any point you are opinion with the prosecutor, you will find a verdict for him.

If upon all the points you are opinion of for the defendant, you will find a verdict for him.

Verdict for the crown.

10th Nov. 1785. – *Adair*, Sgt. applied for rule to show cause why there has not be a new trial, on the following grounds, set forth in the affidavit of the defendant and another person.

That he was led to suppose, that upon two trials on the question of such importance, no evidence that appeared material to the party would have been suppressed and kept back, and that they had gone

into all the cases that could be made against the patent; that under these apprehensions he did not expect them to adduce, in the next stage of the business, and after so many trials, evidence to attack that which he was conscious could not be justly attacked, the originality of the invention. He went, therefore, into the defense, and instructed his counsel, with a view to the question merely of specification, and came to the trial on the *scire facias* altogether unprepared with respect to the evidence that appeared as to the novelty of the invention, except so far as it witnesses that were accidentally called to explain the specification could speak on the subject: that he, consequently, was not prepared with that evidence which he would have adduced to contradict and explain the evidence to deprive him of the originality of the invention. Also, that he could adduce evidence to explain the use of several articles in the specification, said to have been introduced only for the purpose of puzzling and perplexing

That the evidence respecting the wants of novelty of the crank could be contradicted most positively by fresh evidence.

LORD MANSFIELD, CJ: is very clear to me, upon your own showing, that there is there is no doubt the rule; the ground of it is, if there is another trial, you may have more evidence. There is no surprise stated, no new discovery, but, upon the material points in question, you can give more evidence. There were two questions to be tried, that is, the specification and the originality of the invention; there has been one trial in this court, another trial in the Common Pleas, where this patent has been question, and this proceeding is brought finally to conclude the matter, for it is a *scire facias* to repeal the letters patent. The questions to be tried are

stated upon the record; there is not a child but must know they were to try the questions there stated; they come prepared to try them, they have tried them, and a verdict has been found which is satisfactory to the judge, and now you desire to try the same cause again only that you may bring more evidence. Rule refused.

On 14 November, 1785, the court of King's bench gave the judgment to cancel the patent.